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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,077	03/18/2004	Kia Silverbrook	FPD005US	5184
24011 7590 08/22/2008 SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA			EXAMINER PARK, CHAN S	
			ART UNIT 2625	PAPER NUMBER
			MAIL DATE 08/22/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/803,077

Applicant(s)

SILVERBROOK, KIA

Examiner

CHAN S. PARK

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 10, 13, 15, 17, 19, 21-26, 29-31 and 33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-3, 10, 13, 15, 17, 19, 21-26, 29-31 and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/16/08 has been entered.

Response to Amendment

2. Applicant's amendment was received on 7/16/08, and has been entered and made of record. Currently, **claims 1-3, 10, 13, 15, 17, 19, 21-26, 29-31 and 33** are pending.

Response to Arguments

3. Applicant's arguments with respect to **claims 1-3, 10, 13, 15, 17, 19, 21-26, 29-31 and 33** have been considered but are moot in view of the new ground(s) of rejection.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. **Claims 1-3, 10, 13, 15, 17, 19, 21, 22, 26, 30 and 31** are rejected on the ground of nonstatutory double patenting over claims 1-6, 9-14, 16 and 17 of U. S. Patent No. 7,125,185. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of Patent '185 disclose all the limitations in the claims of the instant invention. Furthermore, with respect to claim 31, it claims a stand alone monitor further reciting the limitations of the paper sheet being printed onto passes in certain ways. Since these portions of the claim merely describe the intended use/result of the paper sheet (which is not a part of the claimed monitor) without any structural limitation, there is no patentable weight given to these limitations. (See MPEP 2111.04)

5. **Claims 1-3, 10, 13, 15 and 17** are rejected on the ground of nonstatutory double patenting over claims 1-5 and 10-14 of U. S. Patent No. 7,364,378. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of Patent '378 disclose all the limitations in the claims of the instant invention.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

6. **Claims 23-25** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6, 9-14, 16 and 17 of U.S. Patent No. 7,125,185 in view of Morikawa.

The claims of Patent '185 recites the stand alone monitor claimed in claim 1 of instant application, but it does not explicitly disclose the printhead configured to receive halftoned print data to be printed onto the paper.

Morikawa, the same field of endeavor of the inkjet printing art, discloses an inkjet printer wherein the inkjet printer processes image data/photographic images to generate halftoned print data (col. 9, lines 1-11) and prints the halftoned print data using printhead (col. 9, lines 36-45).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the printhead of Inoue to receive halftoned print data to be printed onto the paper as taught by Morikawa.

The suggestion/motivation for doing so would have been to reduce or eliminate the discontinuous gradation reproduction by applying the halftone processing to the printer of Patent '185 (abstract of Morikawa).

7. **Claim 29** is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6, 9-14, 16 and 17 of U.S. Patent No. 7,125,185 in view of Inoue.

The claims of Patent '185 recites the stand alone monitor claimed in claim 1 of instant application, but it does not explicitly disclose the stand.

Inoue discloses a monitor comprising:

stand holding the flat panel display in an operative position (note that the body supporting the display in fig. 36 is construed as the claimed stand) wherein the stand includes ink cartridge for supplying ink to the printer (the bodying including the printhead 1406 in fig. 36). This particular embodiment of Inoue does not explicitly teach that the stand includes receptacle configured to accept a replaceable ink cartridge. However, Inoue, in the other embodiment, teaches the receptacle for accepting a replaceable ink cartridge (col. 26, lines 53-58). At the time of the invention, it would have been obvious to one of ordinary skill in the art to include this receptacle for accepting a replaceable ink cartridge in order to replace the exhausted cartridge.

8. **Claim 33** is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6, 9-14, 16 and 17 of U.S. Patent No. 7,125,185 in view of Shenoy.

The claims of Patent '185 recites the stand alone monitor claimed in claim 1 of instant application, but it does not explicitly teach that the device is configured to

- receive documents to be printed from a computer system;
- send, from the monitor to the computer system, a print request;
- receive, from the computer system and in response to the print request, a document to be printed; and
- print the document.

Shenoy, the same field of endeavor of printer accepting the print command (a user input for retrieving documents for print in paragraph 45), discloses a printer configured to:

- receive documents to be printed from a computer system (paragraph 57);
- send, from the printer to the computer system, a print request (request for the document in paragraph 57);
- receive, from the computer system and in response to the print request, a document to be printed (receiving/pulling document from the job store 140 in paragraph 57); and
- print the document (paragraph 57).

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At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the device of Patent '185 to include the function of requesting a desired document via the network as taught by Shenoy.

The suggestion/motivation for doing so would have been to save the memory in the printer by saving the print jobs at the external location.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571)272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CHAN S PARK/
Examiner, Art Unit 2625

August 19, 2008